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TRANSCRIPT OF RECORD

Supreme Court of the United States

OCTOBER TERM, [redacted] 1959

No. 597 25

HONORABLE JULIUS J. HOFFMAN, JUDGE OF THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF ILLINOIS, EASTERN DIVISION, PETITIONER,

vs.

JOHN F. BLASKI, et al.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

PETITION FOR CERTIORARI FILED DECEMBER 22, 1958
CERTIORARI GRANTED FEBRUARY 24, 1959

SUPREME COURT OF THE UNITED STATES

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[fol. 1]

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

Civil Action No. 7007

JOHN F. BLASKI, et al.

v.

R. P. HOWELL, JR., et al.

COMPLAINT

To Said Honorable Court:

Now comes John F. Blaski, a resident citizen of the State of Illinois; Peter S. Pedersen, a resident citizen of the State of Illinois; M-P-H Manufacturing Corporation, Inc., a corporation duly organized and existing under the laws of the State of Illinois and having its principal office and place of business in Chicago, Illinois; Peter S. Pedersen, Jr., Edward Martin, and Peter S. Pedersen, Co-Partners, doing business as Central Farm Equipment Company, each resident citizens of the State of Illinois, hereinafter respectively called Plaintiff or Plaintiffs, complaining of R. P. Howell, Jr., a resident citizen of Dallas, Dallas County, Texas, in the Northern District of Texas; and Lifetime Metal Building Co., a Texas corporation, having its principal office and place of business in Dallas County, Texas, where service of process can be had upon R. P. Howell, Jr., the president thereof, hereinafter called Defendant or Defendants, and for such complaint would respectfully show the Court as follows:

I.

That this Honorable Court has jurisdiction of this cause by virtue of United States Code, Title 28, Section 1338, in that this cause arises under an Act of Congress relating to patents as will be hereinafter more fully shown.

II.

That heretofore on February 24, 1948, the United States Patent Office duly and legally issued Patent No. 2,436,543 to [fol. 2] John F. Blaski, Plaintiff herein, entitled "Roof Construction", granting six claims comprising a structural metal panel and method of forming the same, all as is more fully set out and described in the said patent which is adopted and made a part of this complaint. That said patent was issued pursuant to an application by the said John F. Blaski, Plaintiff herein, filed July 11, 1945, Serial No. 604,424 and which patent was thereafter and now is held by the said John F. Blaski under and by virtue of the laws of the United States.

That heretofore on October 17, 1950, the United States Patent office duly and legally issued Patent No. 2,526,323, to John F. Blaski, Plaintiff herein, entitled "Roof Construction", granting eight claims comprising a structural metal panel and method of forming the same, all as is more fully set out and described in the said patent which is adopted and made a part of this complaint. That said patent was issued pursuant to an application by the said John F. Blaski, Plaintiff herein, filed October 18, 1946, Serial No. 704,082, and which patent was thereafter and now is held by the said John F. Blaski under and by virtue of the laws of the United States.

III.

That after the issuance of said patents as above described, John F. Blaski by lawful contract named Peter S. Pedersen as sole and exclusive licensee under said patents and each of them, for the purpose of manufacture and sale of the patented panel and the use and employment of the patented method, and the right to grant sub-licenses to others.

That thereafter by lawful contract Peter S. Pedersen named M-P-H Manufacturing Corporation, Inc. as sub-licensee for the manufacture and sale of the patented panels and for the use and employment of the patented method limited to sales thereof for civilian purposes.

[fol. 3] That thereafter by lawful contract Peter S. Pedersen named Peter S. Pedersen, Jr., Edward Martin and Peter

S. Pedersen, co-partners, doing business as Central Farm Equipment Company as sub-licensee for the manufacture and sale of such patented panels and for the use and employment of such patented method limited to sales thereof for governmental purposes.

That each and all of Plaintiffs named herein have actively and diligently employed the patented method, produced the patented panel, established sales organizations, developed advertising and publicity and have effected the substantial sale, use, and employment of such patented panels with the public throughout the United States, whereby substantial commercial success of the patented panel has been achieved. That each of the Plaintiffs has an identical interest in this cause to the extent of their respective interest in, to, and under said patents and each of them and are entitled to the protection of this Honorable Court as hereinafter prayed for.

IV.

That prior to and at the time of institution of this cause and within the Northern District of Texas the Defendants herein, R. P. Howell, Jr., and Lifetime Metal Building Co. acting together have infringed and are now infringing said patents by employing the method of said patents to produce and sell panels as disclosed and claimed in said patents.

V.

That the Plaintiffs herein employing the patented method and producing the patented panels have heretofore and are now advertising and selling same within the Northern District of Texas. That proper statutory notice of said patents have been applied to the panels so sold, and in said advertising prominent notice is given of the patented nature of the panel for the benefit of the public and these Defendants. [fol. 4] That Defendants herein were and are charged thereby with actual notice of such patents as well as their continuing infringement thereof.

VI.

Plaintiffs would respectfully show the court that the Defendants, heretofore employing the patented methods owned

by Plaintiffs and producing and selling panels covered by patents owned by Plaintiffs, have realized monies and profits which rightfully should have been realized by Plaintiffs all to Plaintiffs' damage measured by not less than a reasonable royalty together with interest as provided by law. Plaintiffs would further show the Court that Defendants are now employing and will continue to employ the method patented to Plaintiffs and to produce the panels patented to Plaintiffs in continuous infringement and damage of the rights secured to Plaintiffs by such patents for the prevention of all of which Plaintiffs here pray for injunction as provided by law.

VII.

That Plaintiffs in protection of their patents against the infringements by the Defendants, and to secure their damages have been suffered to employ legal counsel and to obligate themselves for a reasonable fee for the filing and prosecution of this suit and pray the Court to assess a reasonable sum against said Defendants for Plaintiffs attorneys fees as further damages.

Wherefore, Premises Considered, Plaintiffs pray that Defendants be cited in terms of law to appear and answer herein and upon final hearing Plaintiffs have judgment permanently enjoining the Defendants and each of them from further infringement of said patents as herein alleged; for damages for past infringement of said patents; for reasonable attorneys fees as damages; for all costs in this behalf [fol. 5] expended; and for such other and further relief to which Plaintiffs may be entitled in law or in equity.

Marzall, Johnston, Cook & Root, 135 South La Salle Street, Chicago, Illinois.

John O'C. Fitzgerald, 10 S. LaSalle Street, Chicago, Illinois.

Biggers, Baker, Lloyd & Carver, 2020 Republic Bank Building, Dallas, Texas, RI 2-7755.

[fol. 6]

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

[Title omitted]

ANSWER

Defendants R. P. Howell, Jr. and Lifetime Metal Building Co. answering the Complaint herein, allege:

1. The defendants deny each and every allegation contained in paragraphs IV, VI and VII of the Complaint.

2. The defendants are without knowledge or information sufficient to form a belief as to the truth of each and every allegation contained in paragraphs III and V of the Complaint.

3. The defendants are without knowledge or information sufficient to form a belief as to the truth of each and every allegation contained in paragraph II of the Complaint, except that the defendants deny that U. S. Letters Patents No. 2,436,543 and No. 2,526,323 were duly and legally issued.

[fol. 7] 4. The defendants are without knowledge or information sufficient to form a belief as to the truth of each and every allegation contained in the preamble to the Complaint herein which relates to the several plaintiffs named therein.

Further answering, defendants allege:

5. Neither of the defendants has made, used, sold or practiced any of the alleged inventions purportedly described in the said U. S. Patents No. 2,436,543 and No. 2,526,323, nor have the defendants, or either of them, violated any rights under the said patents.

6. The said U. S. Patents No. 2,436,543 and No. 2,526,323, and each of them, are invalid and void because the said Blaski was not the original and first inventor of the alleged improvements described and claimed therein, but the same, in all of their material and substantial parts, were invented, known to and used by others in this country be-

fore the alleged invention thereof, were patented and described in printed publications in this and foreign countries before the alleged invention thereof, and more than one year prior to the date of the application for the said patent; and were in public use and on sale in the country for more than one year prior to the date of the application for the said patent, and the alleged invention was described in patents granted on applications for patents by others filed in the United States before the alleged invention thereof by the said Blaski.

[fol. 8] 7. The said U. S. Patents No. 2,436,543 and No. 2,526,323, and each of them, are invalid and void for each of the following reasons:

(a) Because the alleged inventions described and claimed therein did not constitute patentable matter within the meaning of the Patent Law.

(b) Because the differences, if any, between the alleged inventions and the prior art are such that the subject matter as a whole would have been obvious, at the time the alleged inventions were made, to a person having ordinary skill in the art to which said subject matter pertains.

(c) Because the alleged inventions purported to be patented thereby and the manner and process of making and using them are not described therein in such full, clear, concise, and exact terms as to enable any person skilled in the art to which they pertain, or with which they are most nearly connected, to make and use the same.

(d) Because the specifications thereof do not contain any claim particularly pointing out and distinctly claiming the subject matter which the patentee claims as his alleged invention.

(e) Because the alleged inventions attempted to be set forth therein are inoperative and devoid of utility.

(f) Because the alleged inventor abandoned the alleged inventions whereby the same became public property.

(g). Because the alleged inventor of the said patents did not duly comply in all respects with the provisions, conditions and requirements of the Patent Laws of the United States in such cases made and provided for the prosecution of the patent applications on which said patents were granted, and the prosecution of said applications before the Patent Office was unlawful and was not in compliance in all respects with the said Patent Laws and with the rules of the Patent Office.

[fol. 9] 8. By reason of the proceedings in the United States Patent Office during the prosecution of the applications which resulted in said Letters Patents No. 2,436,543 and No. 2,526,323, and the admissions and representations therein made by or in behalf of the applicant therein in order to induce the grant of patent upon said applications, the patentee and the plaintiffs are estopped to claim for said letters patents a construction, were the same otherwise possible, such as would cause said letters patents to cover or include any acts of defendants.

Wherefore, the defendants demand judgment dismissing the Complaint herein and awarding them reasonable attorney's fees, together with the costs and disbursements of this action and such other, further and different relief as may be just and proper.

Locke, Locke & Purnell, By /s/ Stanley E. Neely, Attorneys for Defendants, Republic National Bank Building, Dallas, Texas.

[fol. 10] CERTIFICATE OF SERVICE (omitted in printing).

[fol. 11]

IN THE DISTRICT COURT OF THE UNITED STATES
FOR THE NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

Civil Action No. 7007

JOHN F. BLASKI, PETER S. PEDERSEN, M-P-H MANUFACTURING CORPORATION, INC.; PETER S. PEDERSEN, JR., EDWARD MARTIN, and PETER S. PEDERSEN, Co-Partners, doing business as Central Farm Equipment Company, Plaintiffs,

v.

R. P. HOWELL, JR. and LIFETIME METAL BUILDING COMPANY, Defendants.

ORDER OF TRANSFER—April 16, 1957

The defendants having moved for an order transferring the venue of this cause to the United States District Court for the Northern District of Illinois, Eastern Division, and said motion having duly come on to be heard on April 11, 1957, and the Court having heard the argument of counsel and being fully advised, and it appearing to the Court that defendants' motion should be granted for the convenience of parties and witnesses in the interest of justice, it is

Ordered, that this action be transferred from the United States District Court for the Northern District of Texas, Dallas Division, and it is further

Ordered, that the Clerk of this United States District Court for the Northern District of Texas, be and hereby is directed to transfer all records and papers in this action, [fol. 12] together with the deposit made by the plaintiffs, to the Clerk of the United States District Court for the Northern District of Illinois, Eastern Division, together with a certified copy of this order.

Dated April 16, 1957.

.....
United States District Judge

Approved as to Form:

.....
Of Biggers, Baker, Lloyd & Carver
Attorneys for Plaintiffs

.....
Of Locke, Locke & Purnell
Attorneys for Defendants

[fol. 13]

IN THE UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 16686

EX PARTE JOHN F. BLASKI, et al.

Motion for Leave to File Petition for a Writ of Mandamus.

OPINION DENYING MOTION TO FILE PETITION FOR WRIT OF MANDAMUS—June 14, 1957

Before Rivers, Jones and Brown, Circuit Judges.

JONES, Circuit Judge:

The movants here, who were plaintiffs in the district court, have their residence in the Northern District of Illinois. They instituted suit in the district court for the Northern District of Texas against several defendants, all of whom reside in the Northern District of Texas. The complaint charged patent infringement. The defendants made a motion to transfer the cause, pursuant to 28 U.S.C.A. §1404(a), to the Northern District of Illinois. In their motion the defendants stated that their witnesses were much closer to the court in Illinois than to the court in

[fol. 14] Texas. They also stated, among other averments, that there is pending in the district court for the Northern District of Illinois a consolidated action in which the plaintiffs in the Texas suit were charging infringement of the same patent as was involved in the suit in Texas. It was shown that in the action in the Northern District of Illinois much pre-trial information and evidence had been developed which would be relevant in the case commenced in the Northern District of Texas. The defendants waived their right to be sued in the Northern District of Texas and consented to the consolidation of the action with the cause pending in Illinois. An order was entered transferring the cause to the Northern District of Illinois. The plaintiffs, by motion, unsuccessfully sought from the district court an order vacating the order of transfer. The plaintiffs, John P. Blaski and others, have filed in this court their motion for leave to file a petition for a writ of mandamus to require the district court to vacate and set aside the order of transfer. This motion we now consider.

The authority for ordering the transfer is the statutory enactment which provides:

> "For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought." 28 U.S.C.A., §1404(a).

Congress has prescribed venue in patent infringement cases in this language:

> "Any civil action for patent infringement may be brought in the judicial district where the defendant resides, or where the defendant has committed acts [fol. 15] of infringement and has a regular and established place of business." 28 U.S.C.A. §1400(b).

The plaintiffs say that none of the defendants reside in Illinois and have not committed in Illinois any acts of infringement, that process issued in Illinois could not have been served on the defendants and therefore the action could not "have been brought" in the district to which it was transferred. The attempted waiver, the plaintiffs say, is ineffectual.

It has been held in this Circuit that unless the district court has failed correctly to construe and apply the statute, consider the relevant factors incident to a motion to transfer, or has clearly abused its discretion, a Court of Appeals should not entertain applications for mandamus to enter or vacate orders of transfer under §1404(a). Ex Parte Chas. Pfizer & Co., 5 Cir. 1955, 225 F. 2d 720; Ex Parte Pharma-Craft Corporation, 5 Cir. 1956, 236 F. 2d 911. Cf. *Atlantic Coast Line R. Co.* v. *Davis*, 5 Cir. 1950, 185 F. 2d 766. In supporting the position that the district court erroneously construed and applied the statute in the determination, implicit in its order of transfer, that the action might have been brought in the Northern District of Illinois, the plaintiff-movants cite *Blackman* v. *Guerre*, 5 Cir. 1951, 190 F. 2d 427. In that opinion it was said with respect to the cause there decided that the action could not have been transferred under §1404(a) to the District of Columbia because a defendant was a resident of Louisiana. An examination of the opinion will show that the statement of the court was neither necessary to the decision nor upon a question involved in the appeal. [fol. 16] The decision is not a precedent on the question we have before us. The Supreme Court affirmed *Blackman* v. *Guerre* without considering the point with which we are here concerned. *Blackman* v. *Guerre*, 342 U. S. 512, 72 S. Ct. 410, 96 L. Ed. 534.

There are a number of district court decisions holding that even though a defendant moves for a transfer, the court has no power to grant the motion where the defendants are not subject to service in the transferee district. *Hampton Theatres, Inc.* v. *Paramount Film Distributing Corp.*, D.C.D.C. 1950, 90 F. Supp. 645; *Johnson* v. *Harris*, D.C. Tenn. 1953, 112 F. Supp. 338; *Sheridan* v. *Pan-American Refining Corp.*, D.C.N.Y. 1954, 123 F. Supp. 81; *General Electric Co.* v. *Central Transit Warehouse Co.*, D.C.Mo. 1955, 127 F. Supp. 817; *Mitchell* v. *Gundlach*, D.C.Md. 1955, 136 F. Supp. 169; *Felchlin* v. *American Smelting & Refining Co.*, D.C.Calif. 1955, 136 F. Supp. 577. The rule which to us seems the better reasoned and which has been adopted by the majority of the courts, permits the transfer upon the motion or with the consent

of the defendants even though they could not have been served with the process of the transferee court. *Paramount Pictures, Inc.* v. *Rodney*, 3 Cir. 1951, 186 F. 2d 111, cert. den. 340 U. S. 953, 71 S. Ct. 572, 95 L. Ed. 687; *Anthony* v. *Kaufman*, 2d Cir. 1951, 193 F. 2d 85, cert. den. 342 U. S. 955, 72 S. Ct. 629, 96 L. Ed. 710; In re Josephson, 1 Cir. 1954, 218 F. 2d 174; *Torres* v. *Walsh*, 2nd Cir. 1955, 221 F. 2d 319. A number of district court decisions arrive at like results. The purposes for which §1404(a) was enacted would be unduly circumscribed if a transfer could not be made "in the interest of justice" to a district where the defendants not only waive venue but to which [fol. 17] they seek the transfer. The interpretation of the phrase "where it might have been brought", as used in 28 U.S.C.A. §1404(a), is discussed at length by Chief Judge Magruder of the First Circuit in the case of in re Josephson, *supra*. We need not labor the point here.

The district court was empowered by the statute to make the transfer. It is not shown that the district court misconstrued or misapplied the statute or failed to consider all pertinent facts. No abuse of discretion is shown. The rule announced in Ex Parte Chas. Pfizer & Co., *supra*, is applicable. The motion for leave to file a petition for a writ of mandamus is

DENIED.

[fol. 18]

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

Civil Action No. 58 C 127

JOHN F. BLASKI, PETER S. PEDERSEN, M-P-H MANUFACTURING CORPORATION, INC., and PETER S. PEDERSEN, JR., EDWARD MARTIN, and PETER S. PEDERSEN, Co-Partners, doing business as Central Farm Equipment Company, Plaintiffs,

v.

R. P. HOWELL, JR. and LIFETIME METAL BUILDING COMPANY, Defendants.

MOTION BY PLAINTIFFS FOR AN ORDER TRANSFERRING AND REMANDING THIS CAUSE TO THE UNITED STATES DISTRICT COURT, NORTHERN DISTRICT OF TEXAS, DALLAS DIVISION—January 27, 1958

Now come the Plaintiffs in the above-entitled Action, by their undersigned attorneys, and present this their Motion for an Order transferring and remanding the above-entitled cause to the United States District Court for the Northern District of Texas, Dallas Division, on the following grounds:

1. Plaintiffs, on March 1, 1957, filed a complaint in the above-entitled cause in the United States District Court, Northern District of Texas, Dallas Division, Civil Action No. 7007 in that Court;

2. Defendants, on or about March 20, 1957, filed their answer in the above-entitled cause in the United States District Court, Northern District of Texas, Dallas Division;

[fol. 19] 3. The nature of the cause of action alleged in said complaint is that the rights of the Plaintiffs under two United States Letters Patent were and are being infringed by the defendants in the Northern District of Texas, and praying for injunctive relief and damages;

4. All of the defendants in said cause of action reside, and are doing business, within the Northern District of Texas, Dallas Division, while no one of the defendants either resides, or is doing business, within the Northern District of Illinois;

5. The acts of patent infringement alleged in the complaint were committed by the defendants in the Northern District of Texas, and no acts of infringement have been committed by any of the defendants in the Northern District of Illinois within the knowledge or belief of the plaintiffs;

6. The above-entitled Action was properly brought by the plaintiffs in the United States District Court, Northern District of Texas, Dallas Division, under the provisions of Sec. 1400(b), Title 28, U.S.C.A.;

7. The above-entitled cause, over the objections of the plaintiffs, was improperly transferred to this Court by the United States District Court, Northern District of Texas, Dallas Division;

[fol. 20] 8. The reason that said transfer by the United States District Court, Northern District of Texas, Dallas Division, was and is improper, is that Court was and is without power to make such transfer;

9. The Order of transfer of the United States District Court, Northern District of Texas, Dallas Division, was and is a nullity, and is not binding upon this Court, and this Court does not have jurisdiction of this cause of action and should transfer and remand this cause to the United States District Court, Northern District of Texas, Dallas Division, for further proceedings; and

10. For other reasons apparent upon the face of the record.

/s/ Lloyd C. Root, /s/ Daniel V. O'Keeffe, Marzall, Johnston, Cook & Root, 135 South LaSalle Street, Chicago 3, Illinois.

/s/ John O'C. Fitzgerald per LCK, 10 South LaSalle Street, Chicago, Illinois (Attorneys for Plaintiffs).

Chicago, Illinois
January 27, 1958

[fol. 21]

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS

OPINION OF JUDGE JULIUS J. HOFFMAN DENYING MOTION TO TRANSFER—March 14, 1958

The Clerk: 58 C 127. John F. Blaski, *et al.* *versus* R. P. Howell, Jr., and Lifetime Metal Building Company.

The Court: I think I might run through this very fast. This is a motion to retransfer this cause to the Northern District of Texas. It came to me from Judge Perry's calendar, because of the fact the patent involved was the

same as was involved in the other three cases which have gone to Judge Miner.

It appears that the plaintiffs here are residents of the Northern District of Illinois and that the defendants are residents of Texas. The plaintiffs assert that none of the defendants resides or does business in the Northern District of Illinois. The plaintiffs instituted an action for patent infringement in the Northern District of Texas. It is asserted by the plaintiffs that the acts of infringement occurred in the Northern District of Texas and that no acts of infringement occurred in the Northern District of Illinois. As far as I can tell, the defendants have not contested these assertions as to location, and I assume their truth for the purpose of deciding this motion.

Pursuant to 28 USC Section 1404 (a), the defendants moved to transfer the Texas action to the Northern District of Illinois. The trial court granted the motion and [fol. 22] upon appeal by the plaintiffs in the form of mandamus the Fifth Circuit affirmed. The Supreme Court denied certiorari. *Ex parte Blaski*, 245 F. 2d 737 (Fifth Circuit, 1957, *certiorari denied* 355 U. S. 872 (1957). Accordingly the action was brought here.

Now, asserting that the Texas court lacked jurisdiction to transfer the action to Illinois, the plaintiffs moved to transfer the action back to Texas, and in connection with that motion, I refer to the section of the statute with which we are all familiar, but for the record, I will read it:

28 USC Section 1404 (a):

> "For the convenience of the parties and witnesses in the interest of justice a District Court may transfer any civil action to any other district or division where it might have been brought."

28 USC 1400 (b) sets forth the venue requirement in cases of patent infringement:

> "Any civil action for patent infringement may be brought in the judicial district where the defendant resides or where the defendant has committed acts of [fol. 23] infringement and has a regular and established place of business."

If the plaintiffs had instituted action in this district, the defendant could have asserted correctly that venue was improper. We cannot find any relevant code provision pertaining to service of process in patent cases. Therefore I conclude that this case is governed by the general provision of Rule 4(f) of the Federal Rules of Civil Procedure, entitled "Territorial limits of effective service."

> "All process other than a subpoena may be served anywhere within the territorial limits of the state in which the District Court is held."

Although the plaintiffs have not so specifically alleged, it appears from the uncontradicted assertions of the plaintiffs that service of process upon the defendants could not be had in this district.

The plaintiffs in their brief assert that this district is not one in which the action might have been brought, using the words of 1404(a); that the Texas Court lacked jurisdiction to transfer this action; that this court may inquire into the jurisdiction of the Texas Court and that this court [fol. 24] must remand the action to Texas.

The defendants assert that the jurisdiction of the transferor court has already been determined by the Fifth Circuit and that the issue is therefore *res judicata*, and that if this court were to remand, the Texas court would refuse to accept the case. Initially, it must be determined whether this court may inquire into the jurisdiction of the Texas Court to transfer the action. I am of the opinion that this court may so inquire and that the doctrine of *res judicata* and the law of the case raise no barrier to such inquiry.

Absent 1404(a) a District Court would have no authority to transfer an action to another district, nor would a district court have authority to accept such a transfer.

Section 1404(a) was enacted to provide such authority or jurisdiction. Consequently the inquiry is one pertaining to jurisdiction of the Texas court to transfer the action. *Foster-Milburn* v. *Knight*, 181 F. 2d 949 (Second Circuit, 1950); and to the jurisdiction of this court to accept the transfer, *Fettig Canning Co.* v. *Steckler*, 188 F. 2d 715

[fol. 25] (Seventh Circuit). The transferee court must inquire into the jurisdiction of the transferor court.

United States v. *Reid*, 104 F. Supp. 260 (E. D. Arkansas, 1952).

Wilson v. *Kansas City Southern Railway Company*, 101 F. Supp. 56 (Western District of Missouri, 1951).

A transferee court must inquire into its own jurisdiction to accept the transfer.

Fettig v. *Steckler* which I mentioned before.

If either court lacks jurisdiction, the transferee court must remand the case to the transferor court.

Again I refer to the *Fettig* case and the *Reid* case, in that connection, and also the *Wilson* case.

The action of the transferee court is reviewable by mandamus. The *Fettig* case was a mandamus case involving Judge Steckler of Indianapolis.

The doctrine of *res judicata* and the law of the case, as I said a moment ago, cannot be imposed to remedy defects in jurisdiction.

That was said in the *Reid* case. Consequently I must determine whether the Texas court had jurisdiction to [fol. 26] transfer this case. I think the Texas court had jurisdiction to transfer the action to any other district where it might have been brought. So essentially the question relates to statutory interpretation in ascertaining the meaning of the phrase "Where it might have been brought."

First, we consider the practice prior to the enactment of 1404(a). At common law a Federal district court, applying the doctrine of *forum non conveniens* could properly dismiss an action without prejudice if there existed another more convenient district in which the plaintiff could reinstitute his action. The doctrine presupposed two forums in which the defendants were amenable to service.

Gulf Oil Company v. *Gilbert*, 330 U. S. 501 at 507 (1946).

Since it appears that the defendants are not amenable to process in Illinois, the doctrine of *forum non conveniens* could not have been applied in the case at bar.

Thus the ultimate issue presented by this motion is whether the same result must obtain under 1404(a) in the light of the phrase "Where it might have been brought." [fol. 27] The reviser's note to 1404(a) says this:

> "Subsection (a) was drafted in conformity with the doctrine of *forum non conveniens*."

Accordingly, early cases interpreting the section stated that the section merely codified the common law doctrine.

> Kaufman, Observations on Transfers, Section 1404(a).
> 10 FRD 595 at 598 (1951).

That is Judge Kaufman of the Southern District of New York.

More recent cases have expressed the view that 1404(a) constituted a substantial revision of the doctrine. *Norwood* v. *Kirkpatrick*, 349 U. S. 29 (1955).

Again I refer you to another article by Judge Kaufman. Further Observations on Transfers, under Section 1404(a) which he wrote for the Columbia Law Review.

> 56 Columbia Law Review, Page 1 (1956).

Although it may be accepted now that 1404(a) is broader in scope than the pre-existing practice, that fact alone does not resolve the question whether 1404(a) presupposes a transferee jurisdiction in which the defendant is amenable to service of process and in which venue is proper. Those [fol. 28] cases which assert that 1404(a) transcends the common law doctrine do not deal with this question.

There is no legislative history of reasonable applicability to the question. Accordingly, recourse must be had to the decided cases.

Four Circuits have considered the question and their decisions stand, I think, for the proposition that where the defendant moves to transfer an action to a district in which venue would be improper and/or the defendant would not be amenable to service of process, a waiver of these defects is effected. And the court has jurisdiction to transfer the action. The Supreme Court has denied certiorari in three cases in which certiorari was sought.

Ex parte Blaski, who is our friend Blaski in these cases; *In re Josephson*, 218 F. 2d 474 (First Circuit, 1954).
Anthony v. *Kaufman*, 193 F. 2d 85 (Second Circuit, 1951).
Certiorari denied, 342 U. S. 955 (1952).
Paramount Pictures v. *Rodney*, 186 F. 2d 111 (Third Circuit, 1951).
Certiorari denied, 340 U. S. 953 (1951).

Accord: *General Casualty Company* v. *Keller*, 154 Fed-
[fol. 29] eral Supplement 45. Eastern District of Wisconsin, 1957, and other district court cases which I do not now have before me.

Neither the Seventh Circuit nor the Northern District has been confronted with the question. In opposition to the cases cited above, other cases support the proposition that the district in which an action might have been brought is one in which venue and amenability to service of process exists apart from any consideration of waiver.

Shapiro v. *The Bonanza Hotel Co.*, 185 F. 2d 777 (Ninth Circuit, 1950).

General Electric Company v. *Central Transit Warehouse*, 127 Fed. Supp. 817 (Western District of Missouri, 1955); *Johnson* v. *Harris*, 112 F. Supp. 338 (Eastern District of Tennessee, 1953); *Hampton Theatres* v. *Paramount*, 90 F. Supp. 645 (D. D. C. 1950) and I suggest looking at the dissenting opinions in the *Paramount* v. *Rodney* case to which I referred a moment ago.

The leading case in support of transfer is the *Rodney* case. There action was instituted in Delaware under the Clayton Act. All 14 defendants moved to transfer to Texas. Although by statute service of process was nationwide in Clayton Act cases, venue in Texas was improper as to five defendants. The trial court determined that it had no jurisdiction to transfer. The defendants sought mandamus, [fol. 30] and it was held that the trial court did have jurisdiction. The problem was treated simply as one of waiver of venue. At pages 114 and 115, it is said:

"Suits embracing the identical subject matter could have been brought against the defendants in any district court in Texas. Moreover, if brought, these suits could have been maintained unless there had been a seasonable objection to the venue by the defendant.

"Even if the doctrine of *forum non conveniens* had been applied under the precise conditions required by the *Gulf Oil Company* v. *Gilbert*, those conditions are met by the instant circumstances, that is to say the Texas Court would have had the power to adjudicate the controversies and would have had jurisdiction of all defendants.

"By joining in the motion to transfer, the defendants have waived any objection to Texas venue and have agreed to submit themselves to a Texas court. We think that consent is to be given the same effect under Section 1404(a) as it would receive under any other [fol. 31] venue statute."

That is the end of that quotation.

Although there was no problem of service of process in the *Paramount* v. *Rodney* case as there is in the case with which we are concerned, the argument of waiver applies with equal vigor to the service of process. Service of process is an element of jurisdiction over the person, which jurisdiction can be waived.

In *Anthony* v. *Kaufman* to which I have alluded before, the plaintiff sued two defendants in New York. Both defendants moved to transfer to California. One of the two defendants was not amenable to service of process in California. The trial court transferred the action. Reviewing the decision of the trial court, Judge Frank stated, 193 F. 2d at 86:

"But here one defendant could have been served in the transferee district while the other defendant which could not have been served has joined in the application for and thus consented to the transfer. That consent is a waiver of lack of venue. If such waiver existed before the plaintiff commenced the suit, it [fol. 32] could have been brought there. We think 28 USC 1404 covers such a case."

In the *Josephson* case to which I have referred there was involved a shareholder's derivative action which was instituted in Massachusetts. The defendant moved to transfer the action to New Mexico where venue was proper but where service of process could not be had. The action was transferred, and the first circuit affirmed. Although the decision rested in large part upon the fact that venue was proper in New Mexico, Chief Judge McGruder specifically approved the *Paramount* and *Anthony* cases in a lengthy dictum. With reference to the problem of the service of process, it was stated at page 186, that is reported in 212 F. 2d,

> "they were already subject to the personal jurisdiction of the United States District Court for the District of Massachusetts by service of process upon them, and this personal jurisdiction was transferred to the United States District Court for the District of New Mexico by the effect of the transfer order."

The three cases which I have just discussed were cited with approval and followed by the Fifth Circuit in *Ex parte Blaski*. That the Fifth Circuit was disposed toward a liberal interpretation of 1404(a) was evidenced by the fol-
[fol. 33] lowing quotation:

> "The purposes for which 1404(a) was enacted would be unduly circumscribed if a transfer could not be made in the interest of justice to a district where the defendants not only waived venue, but to which they seek the transfer."

That is page 738, 245 F. 2d.

Many district court decisions are in accord with these cases. The plaintiffs' brief I observe makes no mention of these cases. Perhaps they would appear in some additional brief and I allowed one to be filed.

Now, as to cases rejecting the transfer to the Northern District of Illinois, as we all know a penetrating analysis of the problem is contained in the dissenting opinion in *Paramount* v. *Rodney*. Judges Hastie and McLaughlin noted that Congress had made specific provision for venue.

In many cases venue may exist in several districts. In their opinion it was logical to permit transfer only to those districts in which statutory venue existed.

At 186 F. 2d 117, it was said:

> [fol. 34] "It seems to us that in rejecting the specific venue provision governing actions under the Clayton Act as definitive of the limits of power to transfer suits under Section 1404(a) this court is holding that the latter statute empowers the District Court to transfer litigation to any district whatever if the court deems such action is just and convenient. In brief, the Court is holding that the concluding phrase in Section 1404(a), 'Where it might have been brought,' is surplusage."

In answer to the argument that a liberal construction of 1404(a) was to be preferred to further the ends of justice and convenience, it was said at page 118:

> "Whatever merit there may be in the matter of policy in the view implicit in the opinion of the court that a district court should be free to transfer cases according to justice and convenience without technical restrictions, we think Congress has not expressed or [fol. 35] embodied that policy in Section 1404(a). If such had been the intention of Congress we think the concluding phrase of Section 1404(a) would have been omitted, but that phrase was included and we should give it substantial effect according to its tenor."

In answering the argument that the concluding phrase of 1404(a) should be interpreted in the light of the rule that defects of venue may be waived, it was said at page 119:

> "But we do not see how the conduct of a defendant after suit has been instituted can add to the forums where 'it might have been brought'. In the normal meaning of words, this language in Section 1404(a) directs the attention of the judge who is considering

the transfer to the situation which existed when the suit was instituted."

In *Shapiro* v. *Bonanza Hotel Co.*, 185 F. 2d 777, coming out of the Ninth Circuit, 1950, the phrase "might have been brought" was interpreted to exclude those districts in which the defendant was not amenable to service of process. However, it is to be noted that plaintiff was the movant and the defendant had not, expressly or by implication, waived service of process.

[fol. 36]

In *United States against Reid*, to which I have referred before, the transferee court remanded to the transferor court because service of process could not have been had in the transferee's jurisdiction. However, again the plaintiff was the movant.

In *Johnson versus Harris*, the district court denied the defendant's motion to transfer, asserting without citation of authorities that statutory venue must exist in the transferee jurisdiction. In *Hampton Theatre against Paramount* to which we have referred, a similar conclusion was reached, again without citation of authorities. In a lengthy dictum in *General Electric Company versus Central Transit Warehouse*, to which we have previously referred, the district judge, now Mr. Justice Whitaker, expressly declined to follow *Paramount against Rodney*, and *Anthony against Kaufman* in a case in which the defendant was the movant for transfer.

Judge Whitaker relied *in toto* upon the reasoning of the dissenter in *Paramount against Rodney*.

Those cases which support the transfer of the case at bar to Illinois are approved in Moore, Federal Rules

[fol. 37]

and Official Forms, page 69, 1956, and Kaufman, Further Observations on Transfers, under Section 1404(a). That is the Columbia Law Review article to which I have previously referred. The plaintiff relies on those cases cited in Section 3 of its memorandum which I am not reading.

In addition, the plaintiff relies upon *Wilson versus Kansas City Southern Railway*, 101 Fed. Supp. 56 (Western District of Missouri, 1951). *Felchlin versus American*

Smelting, 136 Fed. Supp. 577 (Southern District of California, 1955).

The *Fettig* case, *Christopher against American News Company*, 176 F. 2d 11, a Seventh Circuit case decided in 1949.

Chicago, Rock Island and Pacific Railroad versus Igoe, 212 F. 2d 378 (Seventh Circuit, 1954).

In my view, the *Wilson* case is not in point. There the transferee court determined that the transferor court lacked jurisdiction over the person of the defendant. Accordingly the transferee court could not accept the case. It is my view also that the *Felchlin* case is not in point. There the transferee court determined in a diversity case that the law of the transferee state would not permit the plaintiff, a California executor, to main-
[fol. 38] tain the action.

The *Fettig* case is not in point in my view. There an action *in rem* for condemnation of food was instituted in Missouri. The *res* was before the Missouri District Court. By consent the action was transferred to Indiana. However, the *res* was not transferred. Accordingly it was determined that the transferee court lacked jurisdiction over the subject matter of the action.

In the *Christopher* case the defendant moved to transfer an action to New York asserting that companion cases were pending there. In a *per curiam* decision upholding the transfer the Seventh Circuit noted it was unlikely that the New York action could be transferred to Chicago because certain of the New York defendants could not be served in this district. The court's quotation relied upon by the plaintiff in the case at bar was dictum and I think vague, and I believe completely without authoritative value.

In the *Igoe* case the court was concerned only with its own power to review by mandamus the decision of the district court.

In referring to 1404(a), the court by way of dictum for no apparent reason asserted:

> [fol. 39] "This section presupposes two jurisdictions in which venue may be based. *Foster-Milburn Company versus Knight* (Second Circuit), 181 F. 2d 949."

In the cited case the Second Circuit held that upon motion by the plaintiff an action could not be transferred to a jurisdiction in which the defendant was not amenable to service of process. The Second Circuit reaches an opposite conclusion, where the defendant is the movant. I refer you in that connection again to *Anthony* v. *Kaufman*.

Gentlemen, personally I am of the opinion that the dissent in *Paramount against Rodney* is supported by the greater weight of reason and logic and that this Court, if I were to rely on my own personal inclination, should retransfer this case to Texas.

Those cases supporting transfer to this district, I think, do great violence to the established rules of statutory construction.

They seem to create a doctrine of retroactive waiver in order to reach the conclusion that the action might have been brought. I feel, however, I must follow the law as it [fol. 40] appears to me to be established, especially in view of the fact that the Supreme Court has consistently refused to grant certiorari to those cases supporting transfer to this district.

Accordingly, I deny the plaintiff's motion.

[fol. 41]

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

Civil Action No. 58 C 127

JOHN F. BLASKI, et al., Plaintiff,

v.

R. P. HOWELL, JR. and LIFETIME METAL BUILDING COMPANY, Defendants.

ORDER DENYING MOTION TO TRANSFER—March 14, 1958

This cause coming on to be heard on the motion of plaintiffs in the above entitled action for an order transferring

and remanding this case to the United States District Court, Northern District of Texas, Dallas Division, and the court having considered the briefs of counsel for plaintiffs and counsel for defendants, and having prepared memorandum relative to said motion, and being fully informed and advised in and relative thereto,

It Is Hereby Ordered that plaintiffs' motion for an order transferring and remanding this case to the United States District Court, Northern District of Texas, Dallas Division, is denied.

/s/ Julius J. Hoffman, United States District Judge.

[fol. 42]

IN THE UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

No. 12285

JOHN F. BLASKI, PETER S. PEDERSEN, M-P-H MANUFACTURING CORPORATION, INC., PETER S. PEDERSEN, JR., EDWARD MARTIN, and PETER S. PEDERSEN, Co-Partners, doing business as Central Farm Equipment Company, Petitioners,

v.

HONORABLE JULIUS J. HOFFMAN, United States District Judge, Respondent.

PETITION FOR WRIT OF MANDAMUS—Filed March 21, 1958

To the Honorable Judges of the United States Court of Appeals for the Seventh Circuit:

The petition of the above named Petitioners, John F. Blaski, et al, respectfully shows that:

1. Petitioners, (Appendix, page 1) on March 1, 1957, filed a complaint charging patent infringement in a cause of action entitled John F. Blaski, Peter S. Pedersen, M-P-H Manufacturing Corporation, Inc., and Peter S.

Pedersen, Jr., Edward Martin, and Peter S. Pedersen, Co-Partners, doing business as Central Farm Equipment Company, Plaintiffs, v. R. P. Howell, Jr. and Lifetime Metal Building Company, Defendants, in the United States District Court, Northern District of Texas, Dallas Division, Civil Action No. 7007 in that Court;

[fol. 43] 2. The above named defendants, on or about March 20, 1957, filed their answer (Appendix, page 6) in the above mentioned cause in the United States District Court, Northern District of Texas, Dallas Division, and the cause was set for trial on May 31, 1957;

3. The nature of the cause of action alleged in said complaint is that the rights of Petitioners under two United States Letters Patent were and are being infringed by the defendants in the Northern District of Texas, and praying for injunctive relief and damages;

4. All of the aforementioned defendants in said cause of action reside, and are doing business, within the Northern District of Texas, Dallas Division, while no one of the defendants either resides, or is doing business, within the Northern District of Illinois;

5. The acts of patent infringement alleged in the complaint were committed by the defendants in the Northern District of Texas, and no acts of infringement have been committed by any of the defendants in the Northern District of Illinois, within the knowledge or belief of the plaintiffs;

6. The above entitled action was properly brought by the plaintiffs in the United States District Court, Northern District of Texas, Dallas Division, under the provisions of Sec. 1400(b), Title 28, U.S.C.A.;

[fol. 44] 7. The aforementioned cause of action, upon motion of the defendants, over the objections of the Petitioners, was improperly ordered transferred (Appendix, page 11) by the United States District Court, Northern District of Texas, Dallas Division, to the United States District Court, Northern District of Illinois, Eastern Division. Said cause was received and filed in the United States

District Court, Northern District of Illinois, Eastern Division, on January 27, 1958, was given Docket No. 58 C 127, and was assigned to the above identified respondent, the Honorable Julius J. Hoffman;

8. On that same day, namely, January 27, 1958, the Petitioners filed a motion (Appendix, page 18) in said United States District Court, Northern District of Illinois, Eastern Division, for an order transferring and remanding the aforementioned cause of action to the United States District Court, Northern District of Texas, Dallas Division, on the grounds that said United States District Court in Texas did not have the power to make the aforementioned transfer, and that said United States District Court, Northern District of Illinois, Eastern Division, did not and does not have jurisdiction of said cause of action and should transfer and remand same to the United States District Court, Northern District of Texas, Dallas Division, for further proceedings;

9. Briefs were filed by the plaintiffs and the defendants in the United States District Court, Northern District of [fol. 45] Illinois, Eastern Division, with reference to the aforementioned motion of the Petitioners;

10. On March 14, 1958, the respondent, the Honorable Julius J. Hoffman, handed down an oral opinion (Appendix, page 21) finding, contrary to law and to the decisions of this Court, that the United States District Court, Northern District of Texas, Dallas Division, did have the power to so transfer said cause of action, and that the United States District Court, Northern District of Illinois, Eastern Division, did have the power to accept said transfer and did have jurisdiction of said cause of action;

11. On that same day, the respondent, the Honorable Julius J. Hoffman entered an order (Appendix, page 41) denying the Petitioners' motion for an order transferring and remanding said cause of action to the United States District Court, Northern District of Texas, Dallas Division;

12. The reason that said transfer by the United States District Court, Northern District of Texas, Dallas Divi-

sion, was and is improper, is that that Court was and is without power to make such transfer, the Northern District of Illinois, Eastern Division, not being a district or division where the cause of action "might have been brought" within the meaning of Sec. 1404(a), Title 28, U.S.C.A., which is controlling in this matter;

13. The order of transfer of the United States District Court, Northern District of Texas, Dallas Division, was [fol. 46] and is void *ab initio*, and is not binding upon the United States District Court, Northern District of Illinois, Eastern Division, or this Court, and the United States District Court, Northern District of Illinois, Eastern Division, does not have jurisdiction of this cause of action and should remand and transfer the aforementioned cause of action to the United States District Court, Northern District of Texas, Dallas Division, for further proceedings;

14. The Respondent, in his opinion (Appendix, page 25), stated that:

(a) "The transferee court must inquire into the jurisdiction of the transferor court";

(b) "A transferee court must inquire into its own jurisdiction to accept the transfer";

(c) If either the transferor or transferee court lacks jurisdiction, "the transferee court must remand the case to the transferor court";

(d) "The action of the transferee court is reviewable by mandamus"; and

(e) The doctrine of *res judicata* and the law of the case does not raise any barrier to an inquiry by the transferee court as to the jurisdiction of either the transferor or transferee court.

[fol. 47] 15. Also, the Respondent, in his opinion (Appendix, page 39), stated that:

(a) In his opinion the dissent in the case of *Paramount Pictures* v. *Rodney* (CCA-3) 186 F.2d 111 (which

dissent supports the petitioners here) is supported by the greater weight of reason and logic;

(b) If he were to rely on his own personal inclinations, he should have retransferred this case to Texas;

(c) The cases which support the transfer of this case to this district do great violence to the established rules of statutory construction; and

(d) Those cases seem to create a doctrine of retroactive waiver in order to reach the conclusion that the action "might have been brought" in the transferee district.

16. In spite of this strong expression of personal conviction that this case should be remanded to Texas, the Respondent erroneously ruled (Appendix, pages 39 and 40) that he must follow the law as it appears to him to be established by decisions of Courts of Appeals in other Circuits, especially in view of the fact that the Supreme Court has refused to grant certiorari in those cases;

17. In so ruling the Respondent:

(a) Ruled contrary to the law and contrary to the obvious intent of Congress in enacting Sec. 1404(a), Title 28, U.S.C.A.;

[fol. 48] (b) Ruled contrary to the decisions of this Court;

(c) Ruled contrary to the weight of authority as expressed by the Courts of Appeals for the Seventh and Ninth Circuits, and the District Courts in the District of Columbia, and the Fourth, Sixth, Eighth and Ninth Circuits; and

(d) Erroneously construed the denial of certiorari by the Supreme Court of the United States as an affirmance of previously decided cases and having some kind of a binding effect upon him, which construction is contrary to the law as repeatedly expressed by the Supreme Court.

Wherefore, the Petitioners pray:

1. That an order be issued, directed to said Honorable Julius J. Hoffman, Judge of the United States District Court, Northern District of Illinois, Eastern Division, requiring him to show cause in this Court, at a time to be designated, why he should not vacate and set aside his order entered March 14, 1958, and grant the aforementioned motion of the Petitioners that said cause of action be remanded to the United States District Court, Northern District of Texas, Dallas Division;

2. That a Writ of Mandamus issue from this Court directing the Honorable Julius J. Hoffman, as Judge of the United States District Court for the Northern District of [fol. 49] Illinois, Eastern Division, to vacate and set aside his order entered March 14, 1958, and to order said cause of action remanded to the United States District Court, Northern District of Texas, Dallas Division, for further proceedings;

3. That Petitioners have such additional relief and process as may be necessary and appropriate in the premises.

/s/ Lloyd C. Root, /s/ Daniel V. O'Keeffe, Mazzall, Johnston, Cook & Root, 135 South LaSalle Street, Chicago 3, Illinois, /s/ John O'C. Fitzgerald, 10 South LaSalle Street, Chicago, Illinois (Attorneys for Petitioners).

Chicago 3, Illinois
March 21, 1958

[fol. 50]

IN THE UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

Before

HON. W. LYNN PARKINSON, Circuit Judge.

ORIGINAL PETITION FOR WRIT OF MANDAMUS

No. 12285

JOHN F. BLASKI, PETER S. PEDERSEN, M-P-H MANUFACTURING CORP., INC., PETER S. PEDERSEN, JR., EDWARD MARTIN, and PETER S. PEDERSEN, Co-Partners, doing business as Central Farm Equipment Company, Petitioner,

v.

HON. JULIUS J. HOFFMAN, United States District Judge, Respondent.

RULE TO SHOW CAUSE—March 21, 1958

This matter comes before the Court on the petition of John F. Blaski, et al., for Writ of Mandamus and Brief in support.

On consideration whereof, It Is Ordered that Respondent show cause, if any there be, why a Writ of Mandamus should not issue as prayed by Petitioners by filing in the office of the Clerk of this Court an original and four (4) copies of his Response to this Rule on or before April 10, 1958.

[fol. 51]

IN THE UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

Before

HON. J. EARL MAJOR, Circuit Judge.
HON. PHILIP J. FINNEGAN, Circuit Judge.
HON. ELMER J. SCHNACKENBERG, Circuit Judge.

ORIGINAL PETITION FOR WRIT OF MANDAMUS

No. 12285

JOHN F. BLASKI, et al., Petitioners,

v.

HON. JULIUS J. HOFFMAN, United States District Judge, Respondent.

ORDER DENYING PETITION FOR WRIT OF MANDAMUS—
July 1, 1958

This matter comes before the Court on the petition of John F. Blaski, et al., for a writ of mandamus, the response of respondent thereto, filed pursuant to a Rule To Show Cause heretofore issued by this Court, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this Court that the said petition of John F. Blaski, et al., for a writ of mandamus be, and the same is hereby, DENIED.

[fol. 52]

IN THE UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

No. 12285

September Term and Session, 1958

PETITION FOR WRIT OF MANDAMUS ON PETITION FOR REHEARING

JOHN F. BLASKI, et al., Petitioners,

v.

HONORABLE JULIUS J. HOFFMAN, United States District Judge, Respondent.

OPINION GRANTING PETITION FOR WRIT OF MANDAMUS—October 16, 1958

Before MAJOR, FINNEGAN and SCHNACKENBERG, Circuit Judges.

MAJOR, Circuit Judge:

This Court, on July 1, 1958, rendered an opinion denying petitioners' petition for a writ of mandamus. Upon petition for rehearing, it is ordered that such opinion be withdrawn and that all orders entered pursuant thereto be vacated and set aside.

The facts which give rise to the legal issue for decision are not in dispute. Petitioners, as plaintiffs, on March 1, 1957 filed in the United States District Court, Northern District of Texas, Dallas Division (hereinafter referred to as the Texas Court or District), a complaint charging R. P. Howell, Jr. and Lifetime Metal Building Company with patent infringement. Plaintiffs reside or are doing business within the Northern District of Illinois (hereinafter referred to as the Illinois District). The complaint alleged acts of infringement committed by defendants in

[fol. 53] the Texas District, and no acts of infringement, so far as known, committed by either of the defendants in the Illinois District. Service of process was had upon defendants in the Texas District. Defendants answered the complaint and the case was set for trial.

In the meantime, defendants submitted a motion requesting transfer of the action to the Illinois District, under Title 28 U.S.C.A. Sec. 1404 (a), stating in their motion that defendants waived lack of venue in the Illinois District. Over objection of plaintiff (petitioners here), the Texas Court directed that, for the convenience of the parties and witnesses and in the interest of justice, the action be transferred to the Illinois District.

Plaintiffs, after denial of their motion to vacate the order of transfer, filed a petition for writ of mandamus in the United States Court of Appeals for the Fifth Circuit, requesting that Court to issue an order to show cause why a writ of mandamus should not be issued against the Texas District Judge, nullifying the transfer order. The Court of Appeals (5 Cir.) held that the District Court was empowered by statute to make the transfer, and denied leave to file the petition. *Ex Parte Blaski et al.*, 245 F. 2d 737.

The papers and records in the Texas District infringement action were received in the Clerk's Office of the Illinois District pursuant to the transfer order. Thereupon, petitioners filed a motion in the Illinois District for an order directing the transfer of and remandment of the action to the Texas District, on the ground that the Texas Court was without power to order the transfer and, consequently, the Illinois Court did not acquire jurisdiction. A hearing on the petition and response thereto was had before Honorable Julius J. Hoffman, a Judge of the Illinois District and respondent in the instant proceeding. Respondent, on March 14, 1958, entered an order denying petitioners' motion, and in an oral opinion stated his reasons therefor. Thereupon, petitioners filed in this Court the petition now before us for a writ of mandamus directing respondent to order such transfer and remand.

No question is raised, in fact all parties concede that under Sec. 1651 (a), Title 28 U.S.C.A., mandamus is an [fol. 54] appropriate means for testing the legality of the

order in controversy. Furthermore, our jurisdiction, if there be any doubt, is supported by the decision of this Court in *Chicago, R.I. & P.R. Co.* v. *Igoe*, 212 F. 2d 378.

The questions for decision appear to be correctly stated in petitioners' brief, and are as follows:

> "(1) Whether a district court, having proper venue and jurisdiction over defendants in a patent infringement action, has the power under Section 1404 (a), Title 28, U.S.C.A. to transfer the cause of action, on motion of the defendants and over the objections of the plaintiffs, to a district in which venue is not proper; and
>
> "(2) Whether, under such circumstances, the transferee court acquires jurisdiction, or has the power to accept such a transfer."

Two statutory provisions are pertinent: Secs. 1400 (b) and 1404 (a), Title 28 U.S.C.A. Section 1400 (b), a venue provision, specifically applicable to actions for patent infringement, provides:

> "Any civil action for patent infringement *may be brought* in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business. [Italics supplied.]"

Section 1404 (a), relating to change of venue, provides:

> "For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division *where it might have been brought*. [Italics supplied.]"

It is not open to doubt but that petitioners' action was properly brought in the Texas District, where defendants not only resided but where the acts of infringement took place and where defendants had their regular and established place of business. It appears plain, also, that venue could not properly have been laid in the Illinois District. A solution of the problem before us reduces itself to the legal effect to be given the concluding phrase of Sec. 1404 (a), "where it might have been brought." Does that phrase

refer to the district where such an action "may be brought" [fol. 55] under Sec. 1400 (b)? If the question was of first impression, we would have no hesitancy in answering in the affimative. It is a contradiction of terms and does violence to the plain, unambiguous language which Congress has employed, to reason that the Texas Court, with power to transfer the action only to a district "where it might have been brought," could exercise that power by ordering transfer to a district which it could not have been brought.

If the Texas District had the power on motion of defendants to transfer the action to the Illinois District, it likewise had the power on a similar motion to transfer it to any District Court in the United States. Counsel for respondent argues that the Illinois District was one where the action "might have been brought" because it had general jurisdiction of an action for patent infringement and acquired jurisdiction of defendants by their motion to transfer and their consent to trial in the Illinois District. Precisely the same argument could be made in support of the power of the Texas District if transfer had been made to any other District Court in the United States. Counsel's argument, if accepted, renders the phrase "where it might have been brought" meaningless. The transfer provision would be complete absent the phrase of limitation. This phrase, however, cannot be ignored under the guise of statutory construction; to do so amounts to statutory emasculation.

It must be clearly kept in mind that there is no issue of discretion involved in the instant matter either on the part of the Texas District Judge in ordering the transfer or on the part of the respondent in refusing to remand it. The sole issue is that of power on the part of one to transfer, on the part of the other to accept and entertain jurisdiction. Also, the general rule should not be overlooked that a Federal Court has only such jurisdiction or power as Congress has specifically conferred. The venue where a patent infringement action may be brought, as well as the district to which it may be subsequently transferred, has been clearly delineated by Congress.

When Congress provided for transfer to a district "where it might have been brought," it is hardly open to doubt but that it referred to a district where the plain-
[fol. 56] tiff, in a case sought to be transferred, had a right to bring the case. Under the decisions of the Supreme Court and other courts, the action could have been properly brought only in the district (1) where defendant resides or (2) where defendant has committed acts of infringement and has a regular and established place of business. Under the admitted facts, the action could have been properly brought only in the Texas District. Conversely, it could not have been properly brought in the Illinois District.

In *Stonite Products Co.* v. *Melvin Lloyd Co. et al.*, 315 U.S. 561, the question for determination was whether Sec. 48 of the Judicial Code (Title 28 U.S.C.A. Sec. 109) was the sole provision governing venue of patent litigation. Referring to that section, the Court stated (page 562):

> "Section 48 gives jurisdiction of suits for patent infringement to the United States district courts in the district of which the defendant is an inhabitant, or in any district in which the defendant shall have committed acts of infringement and have a regular and established place of business."

On the following page the Court stated:

> "We hold that Section 48 is the exclusive provision controlling venue in patent infringement proceedings."

Section 48, before the Court in Stonite, was the predecessor venue provision to Sec. 1400 (b) of the present Code. The holding in *Stonite*, however, is equally applicable to the present venue provision. *Fourco Glass Co.* v. *Transmirra Products Corp. et al.*, 353 U.S. 222. The Court in the latter case stated (page 228):

> "For it will be seen that Section 1400 (b) is equally clear and, also, that it deals specially and specifically with venue in patent infringement actions."

And again, on the following page:

> "We hold that 28 U.S.C. Sec. 1400 (b) is the sole and exclusive provision controlling venue in patent infringement actions * * *."

See also the recent opinion by Judge Mercer in *Gas Products Corp.* v. *George D. Roper Corp., et al.*, 147 F.Supp. 853.

[fol. 57] When Congress provided for the transfer of a case to a district "where it might have been brought," it meant the district where plaintiff has a recognized right to bring his case under the Venue Act and that this right was unqualified and absolute, not depending upon consent of the defendant, evidenced by waiver, entry of appearance, or otherwise. If when a suit is commenced, plaintiff has a right to sue in that district, independently of the wishes of defendant, it is a district "where it might have been brought." If he does not have that right, independently of the wishes of defendant, it is not a district "where it might have been brought," and it is immaterial that the defendant subsequently acquiesces. The test is, did the plaintiff have an independent right to commence suit in the district to which it is sought to make transfer? If so, it is a district "where it might have been brought"; otherwise, it is not such a district. We recognize, of course, that venue may be waived under proper circumstances, but we do not think it can be waived in a forum in which an action has not and could not have been properly brought by the opposing party. To hold otherwise is to permit a defendant to select a forum not available to a plaintiff as a matter of right, and over plaintiff's objection.

Respondent in his brief states:

> "Petitioners fail to recognize the difference between jurisdiction of the subject matter and venue over the particular defendants. The District Court had jurisdiction of the subject matter at the time the original suit was brought by reason of the very nature of the suit, *i.e.*, patent infringement."

True, every District Court has jurisdiction over patent infringement litigation generally but the suggestion must be novel, certainly not sound, that the Illinois Court ac-

quired jurisdiction of the subject matter of the instant action at the time it was brought in the Texas District. No court, so far as we are aware, in an action for patent infringement or any other, acquires jurisdiction either of the subject matter or of the parties until the action is properly brought in such court. Furthermore, it begs the question to suggest that the Illinois Court acquired jurisdiction via the transfer because that is dependent upon the issue [fol. 58] for decision, that is, whether Congress has endowed the transferring court with power to order the transfer. As shown, the action could not properly have been brought in the Illinois Court, and, therefore, it was not a district "where it might have been brought." Consequently, the Texas Court was without power to order the transfer and the Illinois Court acquired neither jurisdiction nor venue of the action.

Our conclusion is based upon what we think is a clear congressional mandate. In *Ex Parte Collett*, 337 U.S. 55, the Court held that the phrase "any civil action" found in Sec. 1404 (a) was applicable to an action under the Federal Employers' Liability Act. In so doing the Court stated (page 58):

> "The court below relied on the language of Sec. 1404 (a), *supra*, which it regarded as 'unambiguous, direct, clear.' We agree. The reach of 'any civil action' is unmistakable. The phrase is used without qualification, without hint that some should be excluded."

In our view, the phrase "where it might have been brought" contained in the same section is equally unambiguous, direct and clear.

Notwithstanding the emphatic view which we entertain, it must be conceded that a solution of the problem has engendered much controversy in the courts and that there is respectable opposing authority, although upon analysis it is not as imposing as counsel would have us believe. An attempt to distinguish or analyze such cases in detail would unduly prolong this discussion. A reading of all the cases where the question has been considered leads

to the view that the weight of authority sustains our conclusion in the matter.

Respondent asserts that four Courts of Appeals have sustained the power of the court to transfer under the circumstances of the instant case. *Ex Parte Blaski et al.*, 245 F.2d 737 (5 Cir.); *In Re Josephson*, 218 F.2d 174 (1 Cir.); *Anthony* v. *Kaufman*, 193 F.2d 85, and *Torres* v. *Walsh*, 221 F.2d 319 (2 Cir.); *Paramount Pictures, Inc.* v. *Rodney*, 186 F.2d 111 (3 Cir.). We regard *Blaski* as the most important of these cases because the Court refused to entertain a petition for mandamus directing the [fol. 59] Texas District to vacate its order of transfer in the instant case. With great respect for that Court, we think its opinion discloses that it, like some other Courts, confused the issue of power to transfer with that of discretion where the power existed. In its opinion the Court stated (page 738):

> "The purposes for which Sec. 1404 (a) was enacted would be unduly circumscribed if a transfer could not be made 'in the interest of justice' to a district where the defendants not only waive venue but to which they seek the transfer."

This reasoning, so we think, ignores the statutory limitation of the power to transfer to a district "where it might have been brought." More than that, a court has no more right to unduly enlarge than it has to unduly circumscribe a limitation which Congress has specifically provided. In any event, we think the decision of the Fifth Circuit in this matter is erroneous. Such being the case, we are under no more obligation to follow it as the law of the case than that Circuit would be to follow what it considers an erroneous decision by this Court. See *Wilson* v. *Kansas City Southern Ry. Co. et al.*, 101 F.Supp. 56, 60.

In all the other cases above cited, except *Torres* v. *Walsh*, it appears that one or more of the defendants would have been sued in the district to which the action was transferred. Thus, the action "might have been properly brought" in such district. The *Torres* case involved an *in rem* proceeding in admiralty which presented a different situation as to venue and service. Notwithstanding

that some points of distinction may be drawn between the cited cases (except *Blaski*) and the instant case, it is fair to state that all of these cases contain language which in one way or another supports the power of the Texas Court in the instant matter.

The case most relied upon by respondent is *Paramount Pictures, Inc.* v. *Rodney*, 186 F.2d 111. This case was decided by a court of five judges, two of whom dissented (Judges Hastie and McLaughlin). With due respect to the majority, we agree with the reasoning and logic of the dissenting opinion. The dissent states (page 119):

> "But we do not see how the conduct of a defendant after suit has been instituted can add to the forums [fol. 60] where it might have been brought.' In the normal meaning of words this language of Section 1404 (a) directs the attention of the judge who is considering a transfer to the situation which existed when suit was instituted."

In agreeing with the dissenting members of that Court, we find ourselves in good company. In *General Electric Co.* v. *Central Transit Warehouse Co. et al.*, 127 F.Supp. 817, Judge Whittaker (then a District Judge, now a Justice of the Supreme Court) also agreed with the dissenting members in the *Paramount Pictures* case. More than that, he analyzed and distinguished that case on its facts. In our view, the opinion by Judge Whittaker is sound. His reasoning and logic is unassailable and we think he reached the correct result. A striking statement in his opinion, referring to the construction there sought as it is here, of the phrase "where it might have been brought," is (page 826):

> "Would not such construction be to read that phrase entirely out of the statute? Would not such construction permit transfer of the action to *any district desired by the moving defendants*, though they, or some of them, could not have been served with process there, and no statutory venue existed there, and the action could not have been maintained there, without their intentional waiver of venue and entry of general appearance? I think no such treatment can be given to

that phrase in the statute. It, says Judge Learned Hand, '"presupposes at least two forms in which the defendant is amenable to process."' *Foster-Milburn Co.* v. *Knight*, 2 Cir., 181 F.2d 949, 952."

We have read with interest Judge Hoffman's opinion. He makes a fair and detailed analysis of numerous cases. His counsel in this Court stated: "We, as counsel, cannot improve upon the discussion of the law on this subject which was included in Respondent's opinion." We agree that counsel have not improved upon Judge Hoffman's opinion. Among other things he stated:

> "Gentlemen, personally I am of the opinion that the dissent in *Paramount* against *Rodney* is supported by the greater weight of reason and logic and that [fol. 61] this Court, if I were to rely on my own personal inclination should retransfer this case to Texas.
>
> "Those cases supporting transfer to this district, I think, do great violence to the established rules of statutory construction.
>
> "They seem to create a doctrine of retroactive waiver in order to reach the conclusion that the action might have been brought."

After having thus reasoned, he concluded:

> "I feel, however, I must follow the law as it appears to me to be established, especially in view of the fact that the Supreme Court has consistently refused to grant certiorari to those cases supporting transfer to this district."

It thus appears that respondent reasoned one way and decided the other. Certainly he had no sound basis for attaching weight to the fact that the Supreme Court has refused to grant certiorari in the cases supporting transfer. See *Agoston* v. *Commonwealth of Pennsylvania*, 340 U.S. 844, 845.

We have heretofore quoted from Judge Whittaker's opinion in *General Electric Co.* v. *Central Transit Warehouse Co. et al.*, 127 F.Supp. 817, which includes a state-

ment from *Foster-Milburn Co.* v. *Knight* (2 Cir.), 181 F.2d 949, 952, that it (referring to Sec. 1404 (a)) "presupposes at least two forums in which the defendant is amenable to process." This Court, in *Chicago, R.I. and P.R. Co.* v. *Igoe,* 212 F.2d 378, 379 (footnote), cited with approval the statement from the *Foster-Milburn* case. Numerous District Courts have embraced this view of the transfer section. *Ngchtman* v. *Jones & Laughlin Steel Corp.,* 90 F.Supp. 739, 740; *Wilson* v. *K.C. Southern Ry. Co. et al.,* 101 F.Supp. 56; *Johnson* v. *Harris,* 112 F.Supp. 338, 341; *Mitchell* v. *Gundlach,* 136 F.Supp. 169, 172; *Felchlin* v. *American Smelting & Refining Co.,* 136 F.Supp. 577, 581; *Hill* v. *Upper Mississippi Towing Corp.,* 141 F.Supp. 692, 694; *Gilpin* v. *Wilson,* 148 F.Supp. 493.

In the last cited case, the latest which we find on the subject, the Court after reviewing the case law decided that the transferee district must be one where the action might have been originally brought. In so deciding, the Court stated (page 494):

> [fol. 62] "The Court, while recognizing the divergence of authority on this question, is persuaded that a district wherein the action 'might have been brought' infers that the transferee district must be not only a district wherein venue lies and a complaint may be filed, as indeed one may file a complaint at will, but the transferee district must also be one in which the action might have been legally maintained and service of process effected upon the defendant. This view comprises the weight of authority and is represented by well-reasoned decisions from both the Second and Ninth Circuits."

(*Foster-Milburn Co.* v. *Knight,* 2 Cir., 181 F.2d 949, and *Shapiro* v. *Bonanza Hotel Co.,* 9 Cir., 185 F.2d 777.) The Court in *Gilpin* cites other cases which have expressed the same view, including *Blackmar* v. *Guerre et al.* (5 Cir.), 190 F.2d 427, 429, wherein the Court stated:

> "Transfer under those sections [1404 (a) and 1406 (a)] is limited to districts where the suit could be originally brought. [Citing cases.]"

In *Ex Parte Collett*, 337 U.S. 55, the Court considered the doctrine of *forum no* (sic) *conveniens* as it relates to Sec. 1404 (a). In that connection, the Court discussed the transfer section together with the venue provision there involved. While the issue in the instant case was not directly involved, we think the reasoning by analogy supports the view that the transferee district must be one where the action could have been properly brought. (See pages 59 and 60.) Counsel for respondent attempt to escape the reasoning of *Collett* on the basis of *Norwood* v. *Kirkpatrick*, 349 U.S. 29, which it is claimed broadened the scope to be awarded Sec. 1404 (a). The suggestion is without merit. *Norwood* had nothing to do with the statutory limitation on the power of a District Court to transfer. The case is concerned solely with the matter of the Court's discretion. The Court stated (page 32):

> "As a consequence, we believe that Congress, by the term 'for the convenience of parties and witnesses, in the interest of justice,' intended to permit courts to grant transfers upon a lesser showing of inconvenience. This is not to say that the relevant factors have changed or that the plaintiff's choice of forum [fol. 63] is not to be considered, but only that the discretion to be exercised is broader."

For a discussion of the *Norwood* case see *Clayton* v. *Swift & Co.*, 137 F.Supp. 219, 221.

So that there will be no misunderstanding as to our position on the power of a District Court to transfer an action to another district, we refer to a recent opinion of this Court. *General Casualty Co.* v. *Grubb*, 253 F.2d 51. Unfortunately this case is sometimes cited in support of the thesis that a District Court has the power to transfer to a forum where the action could not have been originally brought. Whether the issue of power was before the Court in the *Grubb* case the opinion does not disclose. If so, it is evident that the issue was undecided. The case was decided solely on the issue of the District Court's discretion to order the transfer. As the Court stated (page 53):

> "On the other hand, we are appraising discretion exercised under Sec. 1404 by the district court and all we can do is to determine whether the respondent Judge abused it while at the same time, guarding against substituting our discretion for his."

The writ of mandamus is allowed, and respondent is directed to vacate and set aside his order entered March 14, 1958, and to order the action remanded to the United States District Court, Northern District of Texas, Dallas Division.

FINNEGAN, Circuit Judge, Dissenting. An opinion in this case, written by me, and in which Judge Major and Judge Schnackenberg joined with me, was handed down July 1, 1958. Now my two colleagues have changed their position, and on rehearing ordered withdrawal of our earlier unanimous opinion. Since I adhere to my original position of refusing the peremptory writ of mandamus in this case, I am explaining my reasons for dissenting.

At the outset, I underscore two items. (1) The record underlying this current majority opinion has remained unchanged since the day when we three judges handed down our first *Blaski* opinion. (2) John F. Blaski, MPH Manufacturing Corporation, Inc., Peter S. Pedersen, Peter [fol. 64] S. Pederson, Jr., co-partners d/b/a Central Farm Equipment Company, petitioners here, had earlier, October 3, 1955, sought a writ of mandamus in our Court to expunge Judge Tehan's order transferring their case brought in the Eastern District of Wisconsin against Inland Steel Products Company, LeRoy Hermann and Robert Anderson, defendants, from the Eastern District of Wisconsin to the Northern District of Illinois for consolidation with other suits then pending in the latter District Court. Those cases involve the same patent as the case at bar. Judge Schnackenberg joined with Judge Lindley in an order, entered October 3, 1955, denying the petition of Blaski, et al. for mandamus. The petition for a writ of mandamus in that case shows Blaski, et al. challenged the power of Judge Tehan to transfer, or in the alternative, claimed the District Judge abused his discretion.

Ex Parte Blaski, 245 F. 2d 737 (5th Cir. 1957) is the Fifth Circuit's opinion denying leave to file a petition for a writ of mandamus to vacate the order entered by the United States District Court in Texas transferring the case at bar to the Northern District of Illinois. Judge Jones, speaking for the Fifth Circuit, when rejecting the petition presented by Blaski, et al., pointed out (245 F. 2d 737):

> "The movants here, who were plaintiffs in the district court, have their *residence* in the Northern District of Illinois. They instituted suit in the district court for the Northern District of Texas against several defendants, all of whom reside in the Northern District of Texas . . . The defendants made a motion to transfer the cause, pursuant to 28 U. S. C. A. § 1404(a), to the Northern District of Illinois. In their motion the defendants stated that their witnesses were much closer to the court in Illinois than to the court in Texas. They also state, among other averments, *that there is pending in the district court for the Northern District of Illinois a consolidated action in which the plaintiffs in the Texas suit* were charging infringement of the *same patent as was involved in the suit in Texas.* It was shown that in the action in the Northern District of Illinois much pre-trial information and evidence had been developed which would be relevant in the case commenced in the Northern [fol. 65] District of Texas. *The defendants waived their right to be sued in the Northern District of Texas and consented to the consolidation of the action with the cause pending in Illinois.* . . .
>
> "The plaintiffs say that none of the defendants reside in Illinois and have not committed in Illinois any acts of infringement, that process issued in Illinois could not have been served on the defendants and therefore the action could not 'have been brought' in the district to which it was transferred. The attempted waiver, the plaintiffs say, is ineffectual." (Italics supplied)

As I understand Judge Major's opinion in this rehearing, he holds that unless there is venue under 28 U. S. C. § 1400 in at least two forums, a trial judge is restrained from basing any order of transfer on 28 U. S. C. § 1404 (a). In reaching that result Judge Major disagrees, as I view it, with the Fifth Circuit that a transfer is proper on motion of a defendant who consents to the transfer (by waiving venue in the transferor court) even though the defendant is not amenable to venue in the transferee court selected by such movant, I doubt if any one would seriously urge that the *Fourco Glass Co.* v. *Transmirra Corp.*, 353 U. S. 222 (1957) holding precludes all transfers of patent cases when § 1404 (a) is involved, especially after noticing the words "any civil action" used by Congress in § 1404(a).

Literally speaking, the defendants-litigants in the case before us; "waived their right to be sued in the Northern District of *Texas*" [See 245 F. 2d 737]; they did not, with all deference to Judge Major, waive venue "in a forum in which an action had not been and could not be properly brought by an opposing party."

Venue under 28 U. S. C. § 1400 (b) means only the place where these defendants could require the case to be tried and, as a word "venue" refers neither to jurisdiction nor power to decide the case. Locality of trial is a personal privilege which these defendants could waive. *In Re Josephson*, 218 F. 2d 174, 184-185 (5th Cir. 1954), and cases there collected. Venue for commencing patent suits is predetermined by § 1400 (b), but there is nothing in that section contained preventing the place of trial from [fol. 66] being shifted in accordance with the yardsticks of "the convenience of parties and witnesses in the interest of justice," provided by § 1404. These Texas defendants have consented to consolidation of the Texas suit with those long since pending in Illinois.

I think the Fifth Circuit penetrated the problem at hand and soundly concluded that:

> "The rule which to us seems the better reasoned and which has been adopted by the majority of the courts, permits the transfer upon the motion or with the consent of the defendants even though they could

not have been served with the process of the transferee court . . . " (245 F. 2d 737, 738).

Judicial discretion came into play after the defendant waived venue in Texas and consented to the consolidation with Illinois pending litigation on the same patents. Rather than abuse of discretion I find the District Judge in Texas displayed some sound practical common sense. Indeed I think the bare words "where it might have been brought" in § 1404 (a), are being used here as an intellectual go-cart just to wheel the case back again to Texas. This case ought to be resolved on its peculiar facts and against the background of lawsuits begun by Blaski, et al. in Wisconsin and Texas. As I have previously said, there appears to be no legalistic reason just why the respondent judge should overrule the Fifth Circuit. I would deny the petition for writ of mandamus just as I would have struck down a petition in the nature of a writ prohibition, which at least would have been potentially more appropriate.

[fol. 67]

IN THE UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

Before

HON. J. EARL MAJOR, Circuit Judge.
HON. PHILIP J. FINNEGAN, Circuit Judge.
HON. ELMER J. SCHNACKENBERG, Circuit Judge.

PETITION FOR WRIT OF MANDAMUS ON PETITION FOR REHEARING

No. 12285

JOHN F. BLASKI, et al., Petitioners,

v.

HONORABLE JULIUS J. HOFFMAN, United States District Judge, Respondent.

ORDER ALLOWING WRIT OF MANDAMUS—October 16, 1958

This matter comes before the Court on the petition for rehearing filed by petitioners John F. Blaski, et al., and the reply of respondent thereto.

On consideration whereof it is ordered and adjudged by this Court that the opinion of this Court heretofore filed in this matter on July 1, 1958 be, and the same is hereby withdrawn and that all orders entered pursuant thereto be vacated and set aside.

It is further ordered and adjudged by this Court that the petition of petitioners John F. Blaski, et al. for a writ of mandamus be allowed, and the respondent is directed to vacate and set aside his order entered March 14, 1958 and to order the civil action, docket No. 58 C 127, John F. Blaski, et al., plaintiffs, vs. R. P. Howell, Jr. and Lifetime Metal Building Company, defendants, remanded to the United States District Court for the Northern District of Texas, Dallas Division, in accordance with the opinion of this Court filed this day.

[fol. 68]

CORRECTED

IN THE UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

Before

HON. F. RYAN DUFFY, Chief Judge.
HON. PHILIP J. FINNEGAN, Circuit Judge.
HON. ELMER J. SCHNACKENBERG, Circuit Judge.
HON. JOHN S. HASTINGS, Circuit Judge.
HON. W. LYNN PARKINSON, Circuit Judge.
HON. WIN G. KNOCH, Circuit Judge.

ORIGINAL PETITION FOR WRIT OF MANDAMUS

No. 12285

JOHN F. BLASKI, et al., Petitioners,

v.

HONORABLE JULIUS J. HOFFMAN, United States District Judge, Respondent.

ORDER DENYING PETITION FOR REHEARING EN BANC—November 25, 1958

On consideration of the motion of counsel for Philip L. Sullivan, Chief Judge of the United States District Court for the Northern District of Illinois,

It Is Hereby Ordered that the brief as Amicus Curiae of Philip L. Sullivan, Chief Judge of the United States District Court for the Northern District of Illinois, tendered to the Clerk of this Court on October 25, 1958 be filed instanter.

As a majority of the Judges in active service have not voted in favor of granting a rehearing en banc,

It Is Hereby Ordered that the petition for rehearing *en banc* filed herein on October 23, 1958 be, and the same is hereby Denied.

(Finnegan, Circuit Judge: I vote to grant the petition for rehearing en banc.)

(Knoch, Circuit Judge: I vote to grant the petition for rehearing en banc.)

[fol. 69] Clerk's Certificate to foregoing transcript (omitted in printing.)

[fol. 70]

SUPREME COURT OF THE UNITED STATES

No. 597—October Term, 1958

ORDER ALLOWING CERTIORARI—February 24, 1959

The petition herein for a writ of certiorari to the United States Court of Appeals for the Seventh Circuit is granted.

And it is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.